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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/710,979

08/16/2004

Takeshi Ikeda

22040-00036-US1

4978

30678

7590

10/26/2005

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EXAMINER

TRINH, SONNY

ART UNIT

PAPER NUMBER

2687

DATE MAILED: 10/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/710,979

Applicant(s)

IKEDA ET AL.

Examiner

Sonny TRINH

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 August 2004.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-7 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 16 August 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 08/16/04.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1-7 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-7 of copending Application No. 10/905540. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the plurality of rotary dials must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended

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replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. **Claim 1** is rejected under 35 U.S.C. 103(a) as being unpatentable over Lee (U.S. Design Patent number D446,512 S) in view of Badarneh ("Badarneh"; U.S. Patent No. 6,292,562).

Regarding **claim 1**, with reference to figures 1-5, Lee discloses a pen-shaped cellular phone, comprising: a pen tip section (figures 1-5 with the pen tip pointing downward), which is established at the edge of a chassis, having writing component at the edge (figures 1-5); a grip section held by a user used as a writing tool (figures 1-5), which is established at the side of said pen tip section of said cylinder chassis (figures 1-5); a keyboard section whose phone operation keys to input numbers, letters, or codes (figures 1-5). However, Lee does not explicitly disclose that the operation keys are allocated linearly in a longitudinal direction nor the display to perform a phone display near said keyboard section.

In an analogous art, Badarneh teaches a keypad for telephones and the like (abstract). Badarneh further teaches the keys are allocated linearly in a longitudinal direction (figure 1) and a display section to perform phone display near the keys section (figure 2a) (for further details, please see columns 2-3).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to incorporate the display as well as the keys, as taught by Badarneh, in order provide the user with ways to read the status of the communication systems (status of battery, signal strength etc.) as well as means to operate the telephone. The combination of Lee and Badarneh discloses the invention but does not explicitly disclose that the pen shaped telephone has a cylindrical shape. However, since pens are notoriously well known for their cylindrical shape, therefore it would have been obvious and well within the level of a person of ordinary skill in the art to use a

cylindrical shape for the pen shaped telephone in order to allow the user to use the writing tool without having to worry about its orientation.

2. **Claim 6** is rejected under 35 U.S.C. 103(a) as being unpatentable over Lee (U.S. Design Patent number D446,512 S), as modified by Badarneh ("Badarneh"; U.S. Patent No. 6,292,562) and in further view of Nilsson ("Nilsson"; U.S. Patent No. 6,405,029).

Regarding **claim 6**, with reference to figures 1-5, Lee discloses a pen-shaped cellular phone, comprising: a pen tip section, which is established at the edge of a chassis, having writing component at the edge (figures 1-5); a grip section held by a user used as a writing tool, which is established at the side of said pen tip section of said chassis (figures 1-5). However, Lee does not disclose a display section to perform a phone display, which is established in a longitudinal direction on the surface of said cylinder chassis except for at said pen tip section and said grip section; a microphone section to input numbers, letters, or codes by sounds; a sound recognition section to obtain information about said numbers, letters, or codes through recognizing inputted sounds from said microphone section; and a switch section to perform on hook and off hook.

In an analogous art, Badarneh discloses a key pad for telephones and the like (abstract). Badarneh further discloses a display section to perform a phone display, which is established in a longitudinal direction on the surface of said chassis except for at said pen tip section and said grip section (figure 2a, for further details, please see columns 2-3). Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to incorporate the display as well as the keys, as

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taught by Badarneh, in order provide the user with ways to read the status of the communication systems (status of battery, signal strength etc.) as well as means to operate the telephone. The combination of Lee and Badarneh, however, does not disclose a microphone section to input numbers, letters, or codes by sounds; a sound recognition section to obtain information about said numbers, letters, or codes through recognizing inputted sounds from said microphone section; and a switch section to perform on hook and off hook.

In another analogous art, Nilsson discloses a wireless prepaid telephone system with dispensable instruments that allow voice dialing (abstract). Nilsson further discloses the microphone (figure 2, element 28) to input numbers, letters, or codes by sounds; a sound recognition section to obtain information about said numbers, letters, or codes through recognizing inputted sounds from said microphone section (columns 2-3); and a switch section to perform on hook and off hook is inherent so that a user can make and disconnect a phone call.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to incorporate voice control and recognition, as taught by Nilsson, into the system of Lee and Badarneh, in order provide the user with ways to control the pen shaped telephone. The motivation for using voice controlled features is to simplify the instruments (less keys are needed) and also to help user to make a call in a low light condition.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sonny TRINH whose telephone number is 703-305-1961. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lester KINCAID can be reached on 571-272-7922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

10/21/05


SONNY TRINH
PRIMARY EXAMINER